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APRIL 29 2008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Group Art Unit 3612

In re Patent Application of

Winfried Bunsmann et al.

Application No. 10/580,282

Confirmation No.: 4389

Filed: May 23, 2006

Examiner: Patel, Kiran B

"VEHICLE ROOF STRUCTURE FOR MOTOR
VEHICLE"

I, Diane L. Stout, hereby certify that this correspondence is
being facsimile transmitted to the U.S. Patent and Trademark
Office (Fax No. 571-273-8300), on the date of my signature.

Diane L. Stout
Signature

04/11/08
Date of Signature

**Petition Under 37 CFR 1.181 for Withdrawal of Finality of
the Office Action mailed March 21, 2008 and for other necessary action**

PETITION TO BE DECIDED BY DIRECTOR OF TECHNOLOGY CENTER 3610

**EXPEDITED PROCESSING REQUESTED
AFTER FINAL OFFICE ACTION**

Box AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In the final Office Action dated March 21, 2008, the Examiner finally rejected the application, while introducing several new grounds for rejection in Sections 1-4 of the Office Action.

None of the new grounds for rejection made in Sections 1-4 could possibly have been necessitated by amendments to the claims, because no amendments of the claims have been made since the preliminary amendment, which was filed on May 23, 2006, i.e. before the first Office Action on the merits (mailing date: August 15, 2007).

Thus, the Office Action mailed March 21, 2008 can not properly be made final in accordance with MPEP 706.07(a) and it is hereby requested to withdraw the final Office Action and to re-issue the Office Action as a non-final Office Action.

Furthermore, in Section 4 of the final Office Action mailed March 21, 2008, the Examiner reiterated, nearly verbatim, the grounds for rejection recited in Section 1 of the first Office Action on the merits mailed August 15, 2007.

Applicant thoroughly addressed all grounds for rejection made in the Office Action mailed August 15, 2007 in the Amendment filed November 15, 2007, in particular at pages 4-8 thereof.

However, contrary to MPEP 707.07(f), the Examiner has failed to take note of these arguments and has never answered the substance of these arguments.

Therefore, when the Office Action is re-issued, it is requested that the Examiner specifically address the arguments made in the Amendment filed November 15, 2007, so that the examination of this application can be furthered.

Additional requests are indicated at the end of this Petition.

An expedited decision pursuant to MPEP 714.13(V) is hereby respectfully requested, in view of the fact that the mailing date of the pending final Office Action is March 21, 2008 and this Petition will not stay the period for responding. MPEP 1002.

No petition fee is believed to be necessary. However, if a petition fee is required, the Commissioner is authorized to charge Deposit Account No. 13-3080.

Further, it is noted that this Petition is timely filed pursuant to Rule 181(f), as the above-noted final Office Action was mailed less than 2 months ago.

STATEMENT OF FACTS

This application is the US national stage filing of PCT/DE2004/002087, which PCT application was originally filed in the German language. An English translation of the original German description and claims was filed with the PTO when the US national phase was entered.

A preliminary amendment was filed together with the entry into the US national phase in order to conform the specification and claims to USPTO requirements.

A first non-final Office Action was mailed August 15, 2007 and included several rejections under 35 U.S.C. 112, first paragraph. However, despite the fact that all the indicated

grounds appear to question to the clarity of the claims, no rejection under 35 U.S.C. 112, second paragraph was made.

In addition, at the end of Section 1 of the Office Action mailed August 15, 2007, it appears that the Examiner attempted to make an omnibus rejection, contrary to MPEP 707.07(d).

In response to this non-final Office Action, paragraphs [0008], [0048] and [0054] of the specification and the Abstract were amended in the Amendment filed November 15, 2007 in order to improve the clarity thereof.

For the purpose of the present Petition, it is only relevant that none of these amendments implicated elements identified by reference numeral 16 or 24, which were mentioned in Section 1 of the final Office Action mailed March 21, 2008. Therefore, the amendment of these paragraphs and the Abstract could in no way have necessitated the new grounds for objection made in the final Office Action.

The Amendment filed November 15, 2007 did NOT amend the claims in any way. Furthermore, no IDS has been filed at any time after the mailing date of the first Office Action on the merits.

In the Office Action mailed January 2, 2008, the Examiner appears to have completely ignored the arguments made in this Amendment and, contrary to MPEP 1893.03(d), imposed a restriction requirement and a species election requirement pursuant to Rule 141-146 and MPEP 800.

In the Response to Restriction Requirement filed February 4, 2008, the Applicant correctly pointed out that the present application is a US national stage application and thus, the restriction and species election procedure of MPEP 800 is inapplicable to the present application. Moreover, the Examiner had completely failed to substantiate an objection based upon lack of unity of invention. Therefore, no election of claims for further prosecution could be warranted.

In the final Office Action mailed March 21, 2008, the Examiner first made a rejection in Section 1, for which is not possible to understand the intended legal basis therefor. The section heading states "Drawings", the grounds refer to reference numbers not utilized in the pending claims 11-33 and the basis for the rejection appears to quote Section 112, second paragraph, in view of the wording: "fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention."

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Therefore, as best understood by the Applicant, Section 1 of the final Office Action appears to introduce a new rejection based upon Section 112, second paragraph (albeit without citing any legal authority contrary to MPEP 707.07(d)), even though the claims have not been amended since the mailing of the first Office Action on the merits.

In Section 2 of the final Office Action, a new objection to the drawings was made under Rule 1.83(a). This objection merely recites nearly all the features of the independent claims in a scrambled manner and alleges that these features are not shown in the claims, despite the fact that pages 4-8 of the Amendment filed November 15, 2007 already demonstrated that all the features of the claims are supported by the specification and are shown in the drawings. The Examiner failed to allege why or how the Amendment filed November 15, 2007 was insufficient to address the clarity concerns first made in the Office Action mailed August 15, 2007.

In Section 3 of the final Office Action, a new objection to paragraph [0036] of the specification was made, despite the fact that paragraph [0036] has never been amended, such that this objection could have, and should have, been made in the first Office Action mailed August 15, 2007.

Section 4 of the final Office Action repeats all the same grounds for rejection made in the Office Action mailed August 15, 2007, although in a different order. It is not presently understood why the Examiner would rearrange the order of the grounds for rejection, while maintaining all the same grounds.

However, it is also important to note that an entirely new ground for rejection was made in the last mentioned ground for rejection in Section 4, namely: "Claims 11, 25 recite 'at least one guide device'; 'at least one guide element'; and 'a guide path'. It is not clear what the claimed limitation is."

This ground for rejection can not be found in the Office Action mailed August 15, 2007 and thus also constitutes another new ground for rejection that could NOT possibly have been necessitated by an amendment of the claims. Again, no amendments to the claims have been made in response to any action on the merits in this application.

In Section 5, the Examiner withdrew the restriction and species election requirements made in the Office Action mailed January 2, 2008. However, it appears that the Examiner has left open the possibility of re-imposing a restriction and/or species election requirement pursuant to Rules 141-146, despite the unmistakable admonition of MPEP 1893.03(d).

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In Section 6 of the final Office Action, the Examiner made the action final without indicating any legal authority for introducing the several new grounds for rejection in a final Office Action.

ARGUMENT

According to MPEP 706.07(a), "second or subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)." See also, MPEP 1207.04.

As no information disclosure statement was filed in the relevant period (and no prior art rejection has been made) and the claims have never been amended in response to an action on the merits, the Office Action mailed March 21, 2008 can not properly be made final.

As will be demonstrated below, it is respectfully contended that each of the objections/rejections made in the final Office Action could have been made in the non-final Office Action mailed August 15, 2007. Therefore, the Applicant's amendments to the specification in the Amendment filed November 15, 2007 also could not, and did not, necessitate the new grounds for objection/rejection made in the final Office Action mailed March 21, 2008.

A. New grounds for objection/rejection prohibit entry of final rejection

1. Applicant's amendments did not necessitate the new "objection to the drawings"

In Section 1, the Examiner has made objections or rejections of the claims without citing any legal authority, contrary to MPEP 707.07(d). At present, Applicant can not determine on what legal basis the Examiner intends to make these objections or rejection, in view of the mention of drawings, reference number and claims.

However, it is clear that none of the amendments to the specification made in the Amendment filed November 15, 2007 could have in any way necessitated these entirely new grounds for objection, as none of those amendments to the specification implicated elements identified by reference numbers 16 or 24.

In Section 2, the Examiner has objected to the drawings as not showing all the features of the claims. Because neither the claims nor the drawings have been amended since the

Preliminary Amendment filed with the entry into the US national phase, again, this drawing objection is new and can not be first raised in a final Office Action.

2. The new objection to the specification also could not have been necessitated by the Applicant's amendments

In Section 3 of the final Office Action, the Examiner appears to have objected to paragraph [0036] of the specification, which has never been amended.

Therefore, this new ground for objection/rejection can not be first raised in a final Office Action.

3. The new written rejection was not necessitated by the Applicant's amendments

The last mentioned ground for rejection under 35 U.S.C. 112, first paragraph in Section 4 of the final Office Action ("Claims 11, 25 recite 'at least one guide device'; 'at least one guide element'; and 'a guide path': It is not clear what the claimed limitation is.") is entirely new. It can not be found in the grounds for rejection made in Section 1 of the Office Action mailed August 15, 2007.

Therefore, this new ground for rejection also can not be first raised in a final Office Action.

4. The finality of the Office Action mailed March 21, 2008 must be withdrawn

In short, any one of the above-noted new grounds for objection/rejection is sufficient to establish that the Office Action made March 21, 2008 was erroneously made final.

The omnibus rejection made at the end of Section 1 of the Office Action mailed August 15, 2007 can not possibly serve as prior notice of the new grounds for objection/rejection, because omnibus rejections are not permissible in accordance with MPEP 707.07(d).

Therefore, it is requested to withdraw the finality of the last Office Action on the merits, and to re-issue this Office Action as a non-final Office Action, so that the Applicant will have a full and fair opportunity to address the new grounds for objection/rejection.

B. Compliance with MPEP 707.07(f) is requested

In the Remarks attached to the Amendments mailed November 15, 2007, a comprehensive and good-faith effort to address all of the Examiner's grounds for rejection was provided. It is respectfully submitted that these arguments fully overcome the written description rejections made in the Office Action mailed August 15, 2007.

However, rather than address the Applicant's arguments, the Examiner chose to issue a restriction and species election requirement after already having issued a first action on the merits. No attempt to satisfy the requirements of MPEP 811 was made, even though the restriction and species election requirements were (incorrectly) made pursuant to MPEP 800. No facts were given in the Office Action mailed January 2, 2008 to substantiate the alleged serious burden, thereby also violating MPEP 808.01 ("A mere statement of conclusion is inadequate") and 808.02.

When the Applicant demonstrated the error of this restriction and species election requirement in the Response to Restriction Requirement filed February 4, 2008, the Examiner elected to simply repeat previous rejections and add new rejections thereto, never answering the substance of the Applicant's arguments made in the Amendment filed November 15, 2007. MPEP 707.07(f).

It is respectfully submitted that, if the Examiner is required to actually consider the arguments presented in the Amendment filed November 15, 2007, all of the previously made rejections would be overcome.

In any event, the Examiner has provided absolutely no information that will enable the Applicant to develop a position for appeal, as the Examiner has entirely failed to point out how the Applicant's arguments are incorrect or insufficient. Therefore, it is feared that an appeal will be filed and the pending rejections will simply be withdrawn without proceeding to the Appeal Board, which would certainly be a waste of everyone's time and resources.

Therefore, when the Office Action is re-issued as a non-final action, it is respectfully requested that the Examiner be required to address the substance of the arguments made in the Amendment filed November 15, 2007.

C. Clarification of the rejection of the expression "arranged and constructed" is required

In the non-final Office Action mailed August 15, 2007 and the final Office Action mailed March 21, 2008, the Examiner has rejected claims 11 and 25 due to the expression "arranged and constructed". The only basis for this rejection is "It is not clear what the claimed limitation is."

As was pointed out in the Amendment filed November 15, 2007 (page 5), this expression can be found in the claims of more than 1300 issued US patents, including three patents that appear to have been the responsibility of the present Examiner.

It is further noted that the present Examiner has had no objection to the following claim expressions, which were utilized in a substantially similar manner:

"configured and arranged" – US 7,322,630 (claim 6) and US 7,287,795 (claims 1 and 11)

"arranged" – US 7,243,978 (claims 1-5), US 7,178,848 (claims 1, 9 and 11) and US 7,172,232 (claim 1)

"structured and arranged" – US 7,182,380 (claim 12).

Therefore, it is respectfully requested that the Examiner clearly indicate whether the rejection of claims 11 and 25 is based upon legal and/or factual grounds and to establish why such a rejection is not arbitrary and capricious in view of the above-noted examining policy of the USPTO, in general, and the present Examiner, in particular.

D. A ruling concerning the applicability of the unity of invention requirement to the present application is requested

In Section 5 of the final Office Action, the Examiner appears to have indicated that the restriction and species election requirements are merely being held in abeyance, pending further clarification of the issues.

This application is a US national stage filing, for which the unity of invention requirement is applicable in accordance with MPEP 1850 and 1893.03(d).

Thus, the record should be made clear that the Examiner is not entitled to re-impose a restriction requirement and/or a species election requirement in this US national stage filing.

Furthermore, because the Examiner has thus far failed to provide any evidentiary basis for a unity of invention objection, if a unity of invention objection were to possibly be imposed in a future action, it can not be made final.

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Thus, it is requested to indicate for the record that any future-made unity of invention objection can not be made final the first time that it is presented.

Requested Relief

For all the foregoing reasons, it is hereby requested to:

1. Withdraw the finality of the Office Action mailed March 21, 2008 and re-issue this action with a new mailing date as a non-final Office Action,
2. Require the Examiner to substantively address the arguments made in the Amendment filed November 15, 2007, in the event that any previously-made written description rejections are maintained,
3. Require a clarification of the legal or factual ground(s) for rejecting the expression "arranged and constructed" in claims 11 and 25,
4. Rule that the restriction and species election practice of Rule 141-146 is inapplicable to this US national stage application and state for the record that any new unity of invention objection can not be made final the first time that it is presented,
5. Provide any other relief that the Director deems appropriate in view of the present circumstances, and
6. Refund any petition fee that may have been charged to consider this Petition, as it was the fault of the PTO that necessitated the filing of this Petition.

Respectfully submitted,



Mark A. Ussai
Reg. No. 42,195

File No. 016382-9015

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Group Art Unit 3612

In re Patent Application of
Winfried Bunsmann et al.

Application Serial No.: 10/580,282

Confirmation No.: 4389

Filed: May 23, 2006

Examiner: Patel, Kiran B

"VEHICLE ROOF STRUCTURE FOR MOTOR
VEHICLE"

I, Diane L. Stout, hereby certify that this correspondence is
being facsimile transmitted to the U.S. Patent and Trademark
Office (Fax No. 571-273-6651), on the date of my signature.

Diane L. Stout
Signature

04/29/08
Date of Signature

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

STATEMENT PURSUANT TO 37 CFR 1.8(b)(3) AND MPEP 512(IV)

Sir:

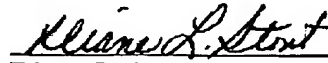
I, Diane L. Stout, am employed by Michael Best & Friedrich LLP, and declare that:

- 1) On April 11, 2008, I personally faxed a 9 page document entitled "Petition Under 37 CFR 1.181 for Withdrawal of Finality of the Office Action mailed March 21, 2008 and for other necessary action" to 571-273-8300;
- 2) It is my signature in the Certificate of Transmission located in the upper right corner of the above-noted Petition;
- 3) Attached hereto is a true and accurate copy of the sending unit's report confirming transmission of the above-noted Petition on April 11, 2008;
- 4) Promptly after sending this facsimile transmission, the same sending unit received a 1-page Auto-Reply Facsimile Transmission from the PTO's Fax Server confirming the PTO's receipt of this document;
- 5) all statements made of my own knowledge are true and all statements made on information and belief are believed to be true and further, these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment,

or both, under 18 USC 1001, and such false statements may jeopardize the validity of the application or any patent issuing thereon.

29 April 2008

Date

A handwritten signature in cursive script, appearing to read "Diane L. Stout", is written over a horizontal line.

Diane L. Stout

HP Color LaserJet 2840

MICHAEL BEST AND FRIEDRIC
215-822-9140
Apr-11-2008 4:06PM



Fax Call Report

Job	Date	Time	Type	Identification	Duration	Pages	Result
2683	4/11/2008	4:01:33PM	Send	15712738300	5:13	9	OK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Group Art Unit 3612

In re Patent Application of

Winfried Baumann et al.

Application No. 10/580,232

Confirmation No.: 4389

Filed: May 23, 2006

Examiner: Patel, Kiran B

"VEHICLE ROOF STRUCTURE FOR MOTOR
VEHICLE"

I, Diana L. Sharp, hereby certify that this correspondence is
being furnished to the U.S. Patent and Trademark
Office (PTO No. 171-473-4309), on the date of my signature.

[Signature]

Date of Signature: 04/11/08

Petition Under 37 CFR 1.181 for Withdrawal of Finality of
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PETITION TO BE DECIDED BY DIRECTOR OF TECHNOLOGY CENTER 3610

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